

### **III) REMARKS**

The Examiner has rejected claims 51-53 and 62-100 under 35 USC 112, second paragraph, objecting to the term "merchant". Applicant has amended the claims to recite "merchant systems" in order to overcome this rejection.

The Examiner has also rejected claims 51-53 and 62-100 under 35 USC 101 for the same reason. Applicant's amendment to the term "merchant system" overcomes this rejection as well.

The Examiner has rejected claims 1-3, 12-53, and 62-100 under 35 USC 103(a) as being unpatentable over Cohagan et al. (US2005/0043992) in view of Official Notice. The Examiner has also indicated that a priority date of March 12, 2004 is acknowledged. Applicant has amended the specification herein to include a reference that this application is a continuation-in-part application of U.S. serial number 10/791,149 filed March 1, 2004, which was inadvertently and unintentionally left out of the original application. Applicant also submits herewith an Application Data Sheet corresponding to this amendment, as well as a Petition for an Unintentionally Delayed Benefit Claim.

Applicant also submits herewith a Declaration of Richard Postrel ("the Postrel Declaration") and a Declaration of Anthony R. Barkume ("the Barkume Declaration"), both of which are provided under 37 CFR 1.131 in support of the establishment of prior invention to overcome the Cohagan reference cited by the Examiner.

As explained in the Postrel and Barkume Declarations, Mr. Postrel first set forth in U.S Patent Application S/N 10/791,149 (METHOD AND SYSTEM FOR ISSUING, AGGREGATING AND REDEEMING POINTS BASED ON MERCHANT TRANSACTIONS - filed March 1, 2004) an embodiment in which a central reward server computer is utilized to store reward point accounts that are each associated with a merchant and with a user, so that reward points may be added to the user's account with a particular merchant when that user executes a purchase transaction with that merchant. Mr. Postrel also disclosed and claimed an alternative embodiment wherein the reward point accounts are stored in an acquiring bank (which is part of the credit card network) rather than in a central reward server computer.

In the '149 application, Mr. Postrel also described how a user's reward points may be aggregated into a single account stored on an exchange server (page 16, line 7 through page 20, line 31). This enables a user to combine points from various accounts. Mr. Postrel described how the exchange server "may be on the same computer as the central server that stores the loyalty records for each merchant and user." (see page 16, lines 20-23), and that "In an alternative embodiment, an issuing bank may fill the role of the exchange server." (see page 20, lines 5-6).

As explained in each of the Declarations, after the '149 application was filed on March 1, 2004, and at least as early as March 10, 2004, I discussed with Mr. Postrel how the description in the '149 application of (a) how the issuing bank may provide the exchange server, along with my

description of (b) that the individual reward accounts may be stored on the same computer as exchange server, led to the conclusion that the issuing bank may store the individual reward accounts as well as the exchange server accounts. As a result of our conversation, I prepared, at least as early as March 10, 2004, a new provisional patent application that incorporated the specific details of the embodiment described above in which the issuing bank may store the individual reward accounts as well as the exchange server accounts.

Mr. Postrel reviewed the provisional application and authorized its filing in the U.S. Patent and Trademark Office on March 12, 2004. This provisional patent application was assigned serial number 60/552,689. Mr. Postrel and I then proceeded to work on a nonprovisional patent application covering this embodiment, which was filed on March 25, 2004 as U.S. serial number 10/809,185 (which is this application).

Although the benefit claim to the '149 application was unintentionally omitted, the specification has been amended herein to include such benefit claim and a Petition for an Unintentionally Delayed Benefit Claim is submitted herewith.

Thus, Applicant respectfully submits that at least independent claims 1 and 51 are supported by the disclosure of the '149 application as explained herein, and thus the effective filing date of at least these claims is March 1, 2004. As such, the Cohagan reference is eliminated as prior art to this application since the filing date of

Cohagan is March 11, 2004.

In the alternative, if the Examiner determines that the '149 application is not sufficient to support the claims at hand, then Applicant respectfully submits that the Cohagan reference has been antedated in accordance with 37 CFR 1.131 as evidenced by the Postrel Declaration and the Barkume Declaration. That is, the disclosure referenced above from the '149 application, along with the work performed on the '689 provisional application at least as early as March 10, 2004, evidences conception of the invention set forth in the present claims prior to March 11, 2004. The Applicant has also clearly established due diligence from that date until the filing of the '689 provisional patent application on March 12, 2004.

As such, it is respectfully submitted that the Cohagan reference has been eliminated as a reference, and that the claims should proceed to allowance.

Respectfully submitted,  
/arbarkume/

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